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| 24737 | 7590 | 07/21/2005 | EXAMINER | |
| PHILIPS INTELLECTUAL PROPERTY & STANDARDS P.O. BOX 3001 BRIARCLIFF MANOR, NY 10510 | | | HAFIZ, MURSALIN B | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 2814 | |

DATE MAILED: 07/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/883,438

Applicant(s)

BUTAYE ET AL.

Examiner

Mursalin B. Haifz

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 January 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 and 9-10 is/are rejected.
- 7) ☒ Claim(s) 8 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06/18/2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 6/18/01, 3/12/02, 4/22/02
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

1. Applicant's election with traverse is acknowledged and persuasive. Therefore, the restriction requirement is withdrawn and claims 1 to 10 will be treated herein.

Drawings

2. The drawings are objected to because Fig. 1 does not show the elements 10 and 11, given that the Fig. 2 is the cross sectional view of Fig. 1. Furthermore, in Fig. 2 elements 10 and 11 do not match with the specification and/or elements 10 and 11 refer to the same item. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

3. The disclosure is objected to because of the following informalities: In page 5 line 24 "low-resistance or insulating material...forming an insulating layer 9," where "low-resistance" material and "insulating" material contradicts each other.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Particularly, in the claim 1 where it says "at least one inductive element superposed on the conductive layer formed by a metallic turn having an outer contour and an inner contour, which bound between them a surface referred to as the radiation surface and means for insulating the conductive layer from the inductive element, which integrated circuit is characterized in that the conductive layer has a surface substantially identical to the surface." It is indefinite, what the inventor means by "inner contour", "outer contour" and "radiation surface." For purpose of this office action, "inner contour" is considered as the inside most contour (contour around the center point) of the inductive element, "outer contour" is considered as the outer most contour of the

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inductive element, and "radiation surface" is considered as the bounded region by the "inner contour" and "outer contour."

Furthermore, claim 3 inventor claims, "conductive layer forms an open circuit" whereas, the conductive layer is not part of any circuitry.

In claim 7, "said well having at least one slot over its entire height" does not describe the invention clearly, because it is not clear from the description of page 6 line 20 that refers to Fig. 2, how the "slot" is formed on the entire height of the well and/or where the slot is. The drawing discrepancy is mentioned above.

Remaining claims are rejected based on their dependency.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-6 as best understood are rejected under 35 U.S.C. 102(b) as being anticipated by Yue (WO 98/50956).

Regarding claim 1, Fig. 4A, 4B, 4C, 4D, and 4E of Yue discloses

a substrate [16],

a conductive layer [30],

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at least one inductive element [10] superposed on the conductive layer and formed by a metallic turn having an outer contour [outer most contour of inductive element] and an inner contour [contour around center point of inductive element], which bound between them a surface referred to as the radiation surface, and means [20] for insulating the conductive layer from the inductive element, which integrated circuit is characterized in that the conductive layer [30] has a surface substantially identical to the radiation surface [inner contour and outer contour bounded surface of 10].

Regarding claim 2, Yue discloses an active zone is integrated on a surface not covered by the radiation surface [Page 14 lines 1 to 11].

With respect to claim 3, in Fig. 4C, Yue discloses the conductive layer forms an open circuit [by means of gap 37].

Regarding claim 4, in fig. 4C, Yue discloses conductive layer includes conductive segments [34].

Regarding claim 5, in Fig. 4C, Yue discloses conductive segments [34] are connected to a non-closed [37] frame.

Regarding claim 6, The limitation "the substrate is formed with trenches perpendicular to the turn of the inductive element, the bottom of said trenches being covered with a low-resistance or conductive material, which forms the conductive layer" is drawn to a process by which the product is made. Yue discloses identical product which is claimed in claim 6 [see Fig. 4A and page 8 lines 1 to 12]. Note that a "product by process" claim

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is directed to the product per se, no matter how actually made, In re Hirao, 190 USPQ 15 at 17 (footnote 3). See also In re Brown, 173 USPQ 685; In re Luck, 177 USPQ 523; In re Fessmann, 180 USPQ 324; In re Avery, 186 USPQ 161; In re Marosi et al., 218 USPQ 289; and particularly In re Thorpe, 227 USPQ 964, all of which make it clear that it is the patentability of the final product per se which must be determined in a "product by process" claim, and not the patentability of the process, and that an old or obvious product produced by a new method is not patentable as a product, whether claimed in "product by process" claims or not. Note that applicant has the burden of proof in such cases, as the above case law makes clear.

6. Claims 1-5, 7, 9, and 10 as best understood are rejected under 35 U.S.C. 102(e) as being anticipated by Jovenin et al (6,529,720 B1).

With respect to claim 1, Fig. 1 of Jovenin discloses

a substrate [2],

a conductive layer [6],

at least one inductive element [4] superposed on the conductive layer and formed by a metallic turn having an outer contour [outer most contour of inductive element] and inner contour [contour around the center point of the inductive element], which bounded between them a surface referred to as the radiation surface, and

means [see Fig. 4 and Column 4 lines 6-7] for insulating the conductive layer [6] from the inductive element [4], which integrated circuit is characterized in that the conductive layer has a surface substantially

identical to the radiation surface [6 has a surface substantially identical to the radiation surface of 4].

Regarding claim 2, in Fig. 1 Jovenin discloses an active zone [5] is integrated on a surface not covered by the radiation surface.

Regarding claim 3, Jovenin discloses an integrated circuit characterized in that the conductive layer [6] forms an open circuit [column 1, lines 54 to 56]

Regarding claim 4, in Fig. 2 Jovenin discloses an integrated circuit characterized in that the conductive layer includes conductive segments [8].

Regarding claim 5, in Fig. 2 Jovenin discloses an integrated circuit characterized in that the conductive segments [8] are connected to a non-closed frame [10]

Regarding claim 7, Jovenin discloses in column 2 lines 12 to 15, an integrated circuit characterized by the presence of a well of a low-resistance or conductive material, which well has walls surrounding the inductive element completely, said well having at least one slot over its entire height.

With respect to claim 9, Jovenin discloses in claim 6 an oscillator adapted to supply an output signal having a frequency whose value depends on the value of a tuning voltage, characterized in that it is realized in the form of an integrated circuit as claimed in claim 1, and it includes at least one varicap diode connected to the inductive element and arranged to be biased by means of the tuning voltage.

With respect to claim 10, Jovenin discloses in claim 7 an apparatus for receiving signals, comprising:

- . an antenna and filter system enabling the reception of a signal whose frequency, called radio frequency, is selected within a given frequency range, and its conversion into an electronic signal, called radio signal,
- . a local oscillator having a frequency, called oscillation frequency, which is controllable by means of a tuning voltage, and
- . a mixer adapted to receive the radio signal and a signal coming from the local oscillator and to supply an output signal having a fixed frequency equal to the difference between the radio frequency and the oscillation frequency, and
- . a signal processing unit adapted to utilize the output signal of the mixer, which apparatus is characterized in that the local oscillator is an oscillator as claimed in claim 9.

Allowable Subject Matter

7. Claims 8 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mursalin B. Haifz whose telephone number is 571-272-0237. The examiner can normally be reached on m-f 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wael Fahmy can be reached on 571-272-1705. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

mbh


GEORGE ECKERT
PRIMARY EXAMINER